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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,889	10/25/2001	Michael W. Munro	10010672-1	7584

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EXAMINER

HANNE, SARA M

ART UNIT	PAPER NUMBER
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2173

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DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,889

Applicant(s)

MUNRO, MICHAEL W.

Examiner

Sara M Hanne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3, 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "said user-entered portion" in line 2 of Claim 3.

Claim 5 recites the limitation "said message" in line 2 of Claim 5. Claim 7 recites the limitation "said suggested expiration date" in line 2 of Claim 7. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Wu, US Patent 5933477.

As in Claim 1, Wu et al. teaches a method for searching the content of an outgoing electronic message for date information from which an expiration date is related ("checks whether the message has an associated expiration date and time at step 510", Column 4, lines 46-47) and the expiration date to be sent with the content to a recipient ("messaging system 104 sends the message and its associated information", Column 4, lines 29-30 and Figure 3, step 310).

As in Claim 2, a searching action performed on the user-entered portion of the electronic message ("the sending subscriber to indicate, if desired, an expiration date and time for the message", Column 4, lines 17-18).

As in Claim 5, the expiration date to inserted in the electronic message (Column 4, lines 28-33).

As in Claim 6, the recipient receiving the outgoing message and deleting it after the expiration date (Figure 5, Steps 521 and 523-524 and corresponding text).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, US Patent 5933477 and further in view of Leonard et al., US Patent 6721784.

Wu teaches searching the content of an outgoing message for date information and sending an outgoing message including an expiration date based on date information (see Claim 1 rejection *supra*). While Wu teaches the method for searching for date information and including an expiration date to be sent with a message they fail to show the searching of the attachment as recited in Claim 3, and the expiration date to be appended to the electronic message as in Claim 4. In the same field of the invention, Leonard et al. teaches a electronic messaging system similar to that of Wu. In addition, Leonard et al. further teaches inclusion of the attachment with the message to be searched (Column 12, lines 13-16) and the expiration date to be appended to the electronic message (Column 10, lines 32-34 and "The commands may be transmitted in the form of message attributes included in a header that forms a part of the electronic mail object", Column 10, lines 60-62). It would have been obvious to one of ordinary skill in the art, having the teachings of Wu and Leonard et al. before him at the time the invention was made, to modify the searching for date information in an electronic message and sending outgoing message with an expiration date taught by Wu to include the attachment and expiration date appended to the message of Leonard et al., in order to obtain a searching method for date information in an attachment and an way to include the expiration date by setting apart from the message content. One would have been motivated to make such a combination because a more in depth searching

method and a way to signal the receiving user of the inclusion of an expiration date would have been obtained, as taught by Leonard et al.

7. Claims 7-11, 13-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, US Patent 5933477 and further in view of MacPhail et al., US Patent 5107419.

Wu teaches searching the content of an outgoing message for date information and sending an outgoing message including an expiration date based on date information (see Claim 1 rejection *supra*). Wu further teaches a system running on a processing unit allowing the user to construct electronic messages based on inputs from an input device (Column 4, lines 11–20 and Figure 1), as recited in Claim 14, an auto-searching module to search the electronic message for date information (“messaging system 104 checks whether the message has an associated expiration date and time at step 510”, Column 4, lines 46-47) and an electronic messaging program, running on a processing unit (processor 120) receiving electronic messages from a sender (Column 3, lines 57-64), as recited in Claim 17 and the searching to be performed on a received electronic message as recited in Claim 9 (the message is received by the system as it is input by the input device and is received after it is sent). Wu also teaches prompting the sender of the outgoing message for an expiration date (Column 4, lines 16–18). While Wu teaches a system for constructing and a system for receiving electronic messages, auto-searching for date information and prompting the sender of the outgoing message for an expiration date, they fail to show the suggesting expiration dates based on date

information as recited in claims 7, 9, 14, and 17 and confirmation that the user accepts the expiration date as in Claims 8 and 10. In the same field of the invention, MacPhail et al. teaches a messaging similar to that of Wu. In addition, MacPhail et al. further teaches suggesting an expiration date to the user ("The allowable values have been preestablished then appear in a "window" or on a separate screen", Column 7, lines 21-23 and Column 11, lines 18-19) and receiving a confirmation that a sender of an outgoing message accepts the expiration date (Column 7, lines 23-25). It would have been obvious to one of ordinary skill in the art, having the teachings of Wu and MacPhail et al. before him at the time the invention was made, to modify the messaging and receiving system and method with auto-searching for date information and prompting methods taught by Wu to include the expiration date suggestions and selection confirmation of MacPhail et al., in order to obtain a user interface for assigning expiration dates suggested by the system. One would have been motivated to make such a combination because a user-supervised method and system for removing emails after a set date would have been obtained, as taught by MacPhail et al.

As in Claim 11, Wu teaches searching a portion of the electronic message that has been input by the sender of the electronic message user-entered portion of the electronic message (See Claim 2 rejection *supra*).

As in Claim 13, Wu teaches the expiration date to be offset by a determined amount (Column 4, lines 59-63).

As in Claim 16, Wu teaches the input device to be a keyboard (a keyboard is inherent to an email system as in Figure 1, Reference 114)

As in Claim 18, Wu teaches additionally storing a second message if it includes an expiration date accepted by the sender of the second message (Figure 5, Reference 526)

As in Claim 19, Wu teaches deleting the message after the expiration date (See Claim 6 rejection *supra*).

8. Claims 12, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, US Patent 5933477 and MacPhail et al., US Patent 5107419 and further in view of Leonard et al., US Patent 6721784.

Wu teaches searching the content of an outgoing message for date information and sending an outgoing message including an expiration date based on date information with a prompt to the user for a suggested expiration date along with a system running on a processing unit allowing the user to construct electronic messages based on inputs from an input device, an auto-searching module to search the electronic message for date information and an electronic messaging program, running on a processing unit receiving electronic messages from a sender and the searching to be performed on a received electronic message as seen in the rejection of Claims 9, 14 and 17 *supra*. While Wu teaches the method for searching for date information, creating and receiving electronic messages and including an expiration date to be sent with a message, the user being prompted with suggested expiration dates they fail to show the searching of the attachment as recited in the Claims. In the same field of the invention, Leonard et al. teaches a electronic messaging system with expiration dates similar to that of Wu and MacPhail et al. In addition, Leonard et al. further teaches

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inclusion of the attachment with the message to be searched (Column 12, lines 13-16).

It would have been obvious to one of ordinary skill in the art, having the teachings of Wu, MacPhail et al. and Leonard et al. before him at the time the invention was made, to modify the sending and receiving of electronic messages with suggested expiration date prompts and searching of date information taught by Wu and MacPhail et al. in the independent Claims 9, 14 and 17, to include the attachment for searching of Leonard et al., in order to obtain a method for searching for date information in the attachment as well as the general content. One would have been motivated to make such a combination because a more in depth searching method for an electronic message would have been obtained, as taught by Leonard et al.

Conclusion

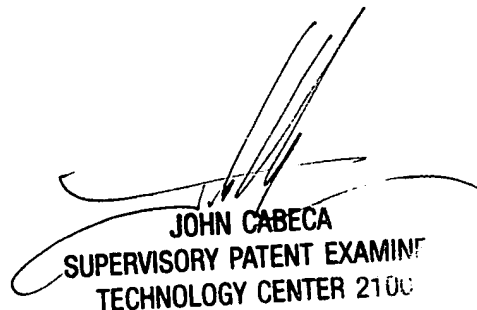
The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar electronic messaging systems with expiration date determinations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (703) 305-0703. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh


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